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10/782,590

02/18/2004

Ewald Mothwurf

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09/21/2006

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EXAMINER

NGUYEN, KIM T

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/782,590

Applicant(s)

MOTHWURF ET AL.

Examiner

Kim T. Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 29-46 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-23 and 29-46 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/18/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Examiner acknowledges receipt of the response to election/restriction on 8/18/06. Upon reconsideration of the restriction requirement issued on 8/18/06, it is determined that the restriction requirement issued on 7/13/06 is withdrawn. Accordingly, claims 1-23 and 29-46 are examined in this office action.

Priority Information

It is noted that the continuity type "Division of the application 09/761,439" claimed in the "Domestic Priority Information" of the data sheet is incorrect. The type "Division" should be changed to "Continuation of the application 09/761,439 which is now issued as U.S. patent No. 6,712,695". A new data sheet with the corrected continuity type should be provided.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in European Patent Office on 1/25/00. It is noted, however, that applicant has not filed a certified copy of the 00101443.0 application as required by 35 U.S.C. 119(b).

Specification

2. The disclosure is objected to because of the following informalities:
 - a) The abstract exceeds 150 words in length. The abstract should be in narrative

form and generally limited within the range of 50 to 150 words, since the space provided for the abstract on the computer tape used by the printer is limited.

b) As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

c) In the specification in page 1, a reference to the prior application must be inserted as the first sentence(s) of the specification of this application, and the updated data such as "now issued as U.S. Patent No. ____", or "now abandoned" should be inserted to the prior application.

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-46 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,712,695. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-46 of the present application disclose the same subject matter as taught in claims 1-35 of the patent No. 6,712,695 in broader scope by eliminating the limitations means for periodically simulating an event and including a plurality of devices for informing patrons of a casino of an impending occurrence of the event and for subsequently displaying a simulation of the event.

Claim Objections

5. Claims 1-46 are objected to because of the following informalities:

- a) In claim 1, line 1, the claimed limitation “the allocation” should be corrected to “an allocation”.
- b) In claim 1, line 10, the claimed limitation “whereby to generate” should be corrected to “to generate”.
- c) In claim 1, line 11, the claimed limitation “a said winning entry” should be corrected to “one of set winning entries”.
- d) In claim 1, lines 11-12, the claimed limitation “the transfer” should be corrected to “a transfer”.
- e) In claim 4, lines 2-3, the claimed limitation “the inputting” should be corrected to “inputting”.
- f) In claim 5, line 3, the claimed limitation “the amount bet” should be corrected to “an amount bet”.
- g) In claim 5, line 5, the claimed limitation “the gaming position” should be corrected to “the gaming positions”.
- h) In claim 11, line 5, the claimed limitation “the respective” should be corrected to “a respective”.
- i) In claim 13, line 2, the claimed limitation “the range” should be corrected to “a range”.
- j) In claim 14, line 3, the claimed limitation “the dynamic” should be corrected to “a dynamic”.
- k) In claim 15, line 2, the claimed limitation “to a player” should be corrected to “to at least one player”.

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l) In claim 15, line 16, the claimed limitation "with value" should be corrected to "with a value".

m) In claim 17, line 3; claim 18, line 3; claim 20, line 3, the claimed limitation "a jackpot" should be corrected to "the jackpot".

n) In claim 29, lines 4-5, the claimed limitation "the parallel computer system(s)" should be corrected to "the parallel computer system".

Due to serious minor informality problems, applicant's cooperation is requested to review and revise the all the remaining claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 43 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 43 is a single means claim, which does not comply with the enablement requirement. *In re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983).

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) In claim 1, line 3, the claimed limitation “including” is ambiguous. It is not clear if it is the “jackpot system” that includes the claimed elements in lines 3-13, or if it is the “gaming positions” that include the claimed elements in lines 3-13, or if it is the “computer network” that include the claimed elements in lines 3-13.

b) In claim 1, lines 4-5, the claimed limitation “and at least output for communicating information” is ambiguous. It is not clear if it is the “computer engine” that has the output, or if it is the “memory” that has the output.

c) In claim 1, line 13, the claimed limitation “and/or to another jackpot” is ambiguous. It is not clear if it is the “and/or” should be interpreted as “and” or “or”. Further, the relation of the limitation to other limitations is not clear, it is not clear the jackpot refers to the “jackpot system” or the “jackpot game”.

d) In claim 1, lines 11-13, the claimed limitation “the transfer of the associated win ... jackpot” is not clear. What the system would transfer, does “win” mean a “payout”, or just “news of winning”?

e) Claim 5, lines 5-6 and 8-12; claim 6, lines 4-6; claim 7, lines 4-5, 9 and 11; claim 8, lines 4-7; claim 11, lines 11-14; claim 15, lines 4-6, 8 and 13; claim 16, lines 5-7 and 9-12, etc., the elements inside the parenthesis “(...)” render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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f) Claim 5, lines 9-10; claim 7, lines 7, 9 and 11; claim 8, lines 4-7; claim 11, lines 13-14 and 17; claim 15, lines 4-6 and 13-14; claim 16, lines 6-7 and 10-11; etc., the phrase "for example or i.e." renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Further, in claim 7, lines 4 and 7, the claimed "like wins" is ambiguous.

g) In claim 5, line 16; claim 17, line 3; claim 18, lines 2-6; claim 19, lines 2-3; claim 20, lines 3-6; claim 21, lines 2-3; claim 22, lines 3-6; claim 23, line 3; claim 43, lines 4-11; etc., the claimed limitation "jackpot" is ambiguous. It is not clear if the "jackpot" is the "jackpot game", or if it is the "jackpot award", or if it is the "jackpot system".

h) In claim 1, last line; claim 5, line 18; claim 11, lines 15 and 18, the claimed limitation "and/or" is ambiguous. It is not clear if the limitation should be interpreted as "and" or "or".

i) In claim 18, line 3; claim 20, line 3; claim 22, line 3, the claimed limitation "a jackpot ... with claim 1" depends on claims 17, 19 and 21, respectively, and further on claim 1. This dependency is confusing.

Due to serious 112, second paragraph, problem, applicant's cooperation is requested to review and revise all the pending claims.

10. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

11. Claim 46 is rejected under 35 U.S.C. 112, fourth paragraph, for failing to limit the subject matter of its parent claim. The claimed limitation "comprising means..." in claim 46 does not further limit the method of testing a jackpot system of claim 46.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-23 and 29-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres (US. patent No. 6,371,852) (Acres '852) in view of Acres et al (US. Patent No. 5,752,882) (Acres '882).

Claims 1-4, 6-8, 15, 23 and 30: Acres '852 discloses a jackpot system. The system comprises a plurality of game positions associated with a computer network (col. 3, lines 7-16) including a computing engine with a memory (col. 5, lines 10-31), a pay table for comparing the generated selection and transferring the winning to the gaming position (col. 7, lines 5-6 and 55-61). Acres '852 does not explicitly disclose the selection generator. However, Acres '852 discloses a reel slot machine (Fig. 2; col. 6, lines 42-43), Acres '852 inherently disclosed the well-known selection generator to randomly select an outcome. Acres '852 does not disclose that the pay table is capable of being configured by an operator. However, Acres '882 discloses allowing the operator to configure the pay table (col. 6, lines 35-55). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include

allowing the operator to reconfigure the pay table in order to allow the owner to adjust the winning award.

Claim 5: Acres '852 discloses inputting the amount bet at a gaming machine (col. 5, lines 10-20).

Claims 9-14: using a random number generator used in conjunction with a counter to receive seed numbers from the counter, and varying the probability of winning in response to amount of bet, or in response to time of day would have been well known to a person of ordinary skill in the art at the time the invention was made.

Claim 16: Acres '852 discloses transferring wins to a plurality of gaming stations (col. 7, lines 51-64).

Claims 17-22: Acres '852 discloses depositing a portion of wager to the jackpot (col. 7, lines 43-44). Further, as to claim 19, winning of one jackpot will trigger into a further jackpot game would have been well known to a person of ordinary skill in the art at the time the invention was made.

Claim 29: implementing a duplicating system to double check the accuracy of the main system would have been well known to a person of ordinary skill in the art at the time the invention was made.

Claims 31-46: refer to discussion in claims 1-23 and 29-30 above.

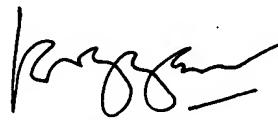
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is 571-272-4441. The examiner can normally be reached on Monday-Thursday during business hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on 571-272-7147. The central official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

kn

Date: September 12, 2006

A handwritten signature in black ink, appearing to read 'Kim Nguyen', with a horizontal line underneath.

Kim Nguyen
Primary Examiner
Art Unit 3713